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AUG 30 2004

OFFICE OF PETITIONS

In re Application of: :  
Donald E. Weder :  
Application No.: 09/764,365 :  
Filed: January 18, 2001 :  
For: OPTICAL EFFECT MATERIAL AND :  
METHODS :

DECISION ON  
PETITION UNDER  
37 CFR 1.181(a)(3)

This is a decision on the petition under 37 CFR 1.181(a)(3) filed on August 2, 2004, requesting supervisory review of the decision of June 2, 2004 terminating proceedings in the above-identified reissue application, and requesting that any termination of proceedings in the above-identified reissue application be held in abeyance pending review by the Board of Patent Appeals and Interferences.

The petition to hold the termination of proceedings in the above-identified reissue application in abeyance is **DENIED**.

Petitioner argues that: (1) the purpose of the reissue statute (35 U.S.C. § 251) is to permit correction of any defect in the original patent that impairs the patentee's rights, provided that the defect crept into the patent without any deceptive intent on the part of patentee; (2) continuity data unnecessary for patentability was mistakenly included in U.S. Patent No. 5,861,199 without any deceptive intent on the part of patentee; and (3) the reissue statute permits correction (elimination of the unnecessary continuity data) in U.S. Patent No. 5,861,199 to reinstate the "full original term" to which the patentee is entitled (petition of August 2, 2004 at 8-9). Petitioner further argues (*inter alia*) that: (1) U.S. Patent No. 5,861,199 is entitled under 35 U.S.C. § 154 to a term of twenty-years from the "**priority date that is necessary for patentability**" (petition of August 2, 2004 9-10, emphasis in the original); (2) the elimination of the unnecessary continuity data from U.S. Patent No. 5,861,199 will not result in an extension of

“the original term of the patent” (petition of August 2, 2004 at 11-12); (3) Brenner v. State of Israel, 400 F.2d 789, 158 USPQ 584 (D.C. Cir. 1968), Sampson v. Commissioner of Patents and Trademarks, 195 USPQ 136 (D.D.C. 1976), and MPEP 1402 each indicate that a failure to make reference to, or incorrectly making reference to, a prior copending application are errors that may be corrected by reissue under 35 U.S.C. § 251 (petition of August 2, 2004 at 10-11); and (4) In re Morgan, 990 F.2d 1230, 26 USPQ2d 1392 (Fed. Cir. 1993), did not involve a situation in which the erroneous inclusion of continuing data or the determination of the unexpired term of the patent were at issue (petition of August 2, 2004 at 6-7). Petitioner requests that any termination of proceedings in the above-identified reissue application be held in abeyance pending review by the Board of Patent Appeals and Interferences.

**U.S. Patent No. 5,861,199 expired on May 23, 2004**

The above-identified application is a reissue application of U.S. Patent No. 5,861,199 (issued on January 19, 1999), which patent resulted from application No. 08/717,469, filed on September 20, 1996. As filed on September 20, 1996, the first sentence of the specification of application No. 08/717,469 refers to (*inter alia*<sup>1</sup>) application No. 06/613,080, filed on May 22, 1984. Petitioner did not amend application No. 08/717,469 to cancel this reference to application No. 06/613,080, filed on May 22, 1984, before application No. 08/717,469 issued as U.S. Patent No. 5,861,199.

Section 251 of title 35, United States Code, first paragraph, provides that:

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Director shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

Sections 154(a)(2) and (a)(3) of title 35, United States Code, provide that:

(2) TERM.—Subject to the payment of fees under this title, such grant shall be for a term beginning on the date on which the patent issues and ending 20 years from the date on which the application for the patent was filed in the United States

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<sup>1</sup> The specification of application No. 08/717,469 also refers to other prior-filed applications. Application No. 06/613,080, filed May 22, 1984, is the earliest filed application to which application No. 08/717,469 refers.

or, if the application contains a specific reference to an earlier filed application or applications under section 120, 121, or 365(c) of this title, from the date on which the earliest such application was filed.

(3) PRIORITY.—Priority under section 119, 365(a), or 365(b) of this title shall not be taken into account in determining the term of a patent.

The first sentence of the specification of application No. 08/717,469, and now U.S. Patent No. 5,861,199, contains a specific reference under 35 U.S.C. § 120<sup>2</sup> to (*inter alia*) application No. 06/613,080, filed May 22, 1984. Cf. Abbott Lab. v. Novopharm Ltd., 104 F.3d 1305, 1309, 41 USPQ2d 1535, 1537 (Fed. Cir. 1997) (the statement that an application is a divisional application of a prior-filed application is a specific reference to the prior-filed application in accordance with 35 U.S.C. § 120 for purposes of 35 U.S.C. § 154(a)(2), regardless of whether the divisional application actually received any benefit from the prior-filed application). Therefore, the term of U.S. Patent No. 5,861,199 is measured from the filing date of application No. 06/613,080, namely May 22, 1984. See id. at 1309, 41 USPQ2d at 1537. Accordingly, U.S. Patent No. 5,861,199 expired on May 23, 2004.<sup>3</sup>

**Patent term under 35 U.S.C. § 154(a)(2) is measured from the earliest application for which a benefit is claimed under 35 U.S.C. § 120, 121, or 365(c), regardless of whether such benefit is necessary for patentability**

Petitioner's argument that U.S. Patent No. 5,861,199 is entitled under 35 U.S.C. § 154 to a term of twenty-years from the priority date that is necessary for patentability is not correct. There is no nexus between patent term under 35 U.S.C. 154(a)(2) and the priority date that is necessary for patentability: (1) the patent term set forth in 35 U.S.C. § 154(a) is measured from the earliest application to which there is a specific reference under 35 U.S.C. § 120, 121, or 365(c), regardless of whether the filing date of such application is necessary for patentability (35 U.S.C. 154(a)(2)); and (2) priority under 35 U.S.C. § 119, 365(a), or 365(b) is not taken into account in determining patent term (35 U.S.C. § 154(a)(3)), even if the priority date is necessary for patentability. The patent term provisions of 35 U.S.C. § 154(a)(2) do not distinguish between

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<sup>2</sup> In addition, the declaration under 37 CFR 1.63 filed in application No. 08/717,469 on September 20, 1996 also states that applicant claims the benefit under 35 U.S.C. § 120 of (*inter alia*) application No. 06/613,080, filed May 22, 1984.

<sup>3</sup> While May 22, 2004 was a Saturday, the provisions of 35 U.S.C. § 21(b) do not operate to extend the expiration date of a patent. Cf. MPEP 2506 (the provisions of 35 U.S.C. § 21(b) will operate to extend the period for payment of a maintenance fee if the last day for payment falls on a Saturday, Sunday, or Federal holiday within the District of Columbia, but will not operate to extend the expiration date of a patent if the maintenance fee is not timely paid). Therefore, U.S. Patent No. 5,861,199 expired on the first moment of May 23, 2004.

those continuity claims under 35 U.S.C. § 120, 121, or 365(c) that are necessary for patentability and those continuity claims that are not necessary for patentability. The Administrative Action Statement accompanying the Uruguay Round Agreements Act (URAA), Public Law 103-465, 108 Stat. 4809 (1994), indicates that “[i]f priority to an earlier application or applications is **claimed** under [35 U.S.C. §] 120, 121, or 365(c), the twenty-year period is measured from the date of the earliest of such applications.” See Uruguay Round Agreements Act: Statement of Administrative Action, H.R. Doc. No. 103-316, at 1002 (1994), reprinted in 1994 U.S.C.C.A.N. 4040, 4295 (emphasis added).<sup>4</sup> That a patent never received any benefit from a prior-filed application for which benefit was claimed under 35 U.S.C. § 120, 121, or 365(c) is immaterial for purposes of the term of the patent as defined by 35 U.S.C. § 154(a)(2). See Abbott Lab. v. Novopharm Ltd., 104 F.3d at 1309, 41 USPQ2d at 1537.<sup>5</sup>

Petitioner’s argument that the elimination of the unnecessary continuity data from U.S. Patent No. 5,861,199 will not result in an extension of “the original term of the patent” is likewise unavailing. 35 U.S.C. § 251 refers to “the unexpired part of the term of the original patent” and does not mention any “original term of the patent.” Petitioner’s argument treats the “unnecessary” continuity claims under 35 U.S.C. § 120 in U.S. Patent No. 5,861,199 as if it were a disclaimer of some “original term” of U.S. Patent No. 5,861,199. The filing date of the earliest filed application for which there is a continuity claim under 35 U.S.C. § 120 (whether now

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<sup>4</sup> Section 102(d) of the URAA (19 U.S.C. § 3512(d)) provides that “[t]he statement of administrative action approved by the Congress under section 101(a) shall be regarded as an authoritative expression by the United States concerning the interpretation and application of the Uruguay Round Agreements and this Act in any judicial proceeding in which a question arises concerning such interpretation or application.” See also RHP Bearings, Ltd. v. United States, 288 F.3d 1334, 1344 n.7 (Fed. Cir. 2002).

<sup>5</sup> In implementing the patent term provision of the URAA, the United States Patent and Trademark Office (USPTO) cautioned applicants that:

Under 35 U.S.C. § 154(a)(2), if an application claims the benefit of the filing date of an earlier filed application under 35 U.S.C. § 120, 121 or 365(a), the 20-year term of that application will be based upon the filing date of the earliest U.S. application that the application makes reference to under 35 U.S.C. § 120, 121 or 365(a). For a CIP application, applicant should review whether any claim in the patent that will issue is supported in an earlier application. If not, applicant should consider canceling the reference to the earlier filed application.

See Changes to Implement 20-Year Patent Term and Provisional Applications, 60 Fed. Reg. 20195, 20205 (Apr. 25, 1995), 174 Off. Gaz. Pat. Office 15, 23 (May 2, 1995) (final rule) (response to comment 5).

deemed necessary or unnecessary) is the date from which the term (or the “original term” using petitioner’s vernacular) of U.S. Patent No. 5,861,199 is measured.

**The elimination of “unnecessary” continuity data via reissue will not change the  
May 23, 2004 expiration date of U.S. Patent No. 5,861,199**

Petitioner’s arguments that (1) the purpose of the reissue statute is to permit correction of any defect<sup>6</sup> in the original patent that impairs the patent rights, provided that the defect crept into the patent without any deceptive intent on the part of patentee, (2) continuity data unnecessary for patent was mistakenly included in U.S. Patent No. 5,861,199 without any deceptive intent on the part of patentee, and (3) the reissue statute permits correction (elimination of the unnecessary continuity data) in U.S. Patent No. 5,861,199, are immaterial. The issue is not whether the reissue statute permits correction (elimination of the unnecessary continuity data) in U.S. Patent No. 5,861,199. The USPTO has indicated that a patentee may delete continuity claims via the filing of a reissue application. See MPEP 1405 (8<sup>th</sup> ed. 2001) (Rev. 2, May 2004).

The issue is whether a continuity claim may be disclaimed after a patent has issued via reissue for the purpose of changing the term of the patent. MPEP 1405 provides with respect to the effect of reissue on patent term that:

The maximum term of the original patent is fixed at the time the patent is granted. While the term may be subsequently shortened, *e.g.*, through the filing of a terminal disclaimer, it cannot be extended through the filing of a reissue. Accordingly, a deletion in a reissue application of an earlier-obtained benefit claim under 35 U.S.C. § 120 will **not** operate to lengthen the term of the patent to be reissued.

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<sup>6</sup> The statement that the purpose of the reissue statute is to permit correction of “any defect” in the original patent that impairs the patentee’s rights, provided that the defect crept into the patent without any deceptive intent, is an overstatement in any event. 35 U.S.C. § 251 is not a panacea for all patent prosecution problems, and is not a second opportunity to prosecute the original application *de novo*. See In re Weiler, 790 F.2d 1576, 1582, 229 USPQ 673, 677 (Fed. Cir. 1986). A reissue applicant’s failure to timely file a divisional application, even in the absence of any deceptive intent, is not considered to be error that is correctable by reissue. See In re Watkinson, 900 F.2d 230, 14 USPQ2d 1407 (Fed. Cir. 1990); In re Mead, 581 F.2d 251, 198 USPQ 412 (CCPA 1978); and In re Orita, 550 F.2d 1277, 1280, 193 USPQ 145, 148 (CCPA 1977). In addition, the “recapture” of claimed subject matter which was surrendered in an application to obtain the original patent, even in the absence of any deceptive intent, is not considered to be error that is correctable by reissue. See Pannu v. Storz Instruments Inc., 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); Hester Industries, Inc. v. Stein, Inc., 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); and In re Clement, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997).

See MPEP 1405 (emphasis in the original).

The issue of whether a continuity claim may be disclaimed after a patent has issued via reissue for the purpose of changing the term of the patent was initially addressed by the USPTO in June of 1995 during the implementation of the URAA. Question and answer 4 of the twenty-year patent term section in Questions and Answers Regarding the GATT Uruguay Round and NAFTA Changes to U.S. Patent Law and Practice provides:

Question: Can a patentee disclaim/claim the benefit of the filing date of an earlier filed application after the patent issues?

Answer: Yes, so long as the conditions of 35 U.S.C. § 251 are satisfied. Note that a disclaimer will not, however, operate to extend the term of a patent as the term of a reissued patent is limited by the unexpired term of the original patent.

See Questions and Answers Regarding the GATT Uruguay Round and NAFTA Changes to U.S. Patent Law and Practice at 8 (June 1995).

Therefore, even if the USPTO had reissued U.S. Patent No. 5,861,199 (prior to May 23, 2004) with a disclaimer of any or all of the benefit claims under 35 U.S.C. § 120 in U.S. Patent No. 5,861,199, such a reissue patent would still have expired on May 23, 2004 by operation of law (35 U.S.C. § 251, ¶ 1) because a reissue patent is limited to “the unexpired part of the term of the original patent.” See 35 U.S.C. § 251, ¶ 1. Since the “term of the original patent” expired on May 23, 2004, the question of what “errors” in U.S. Patent No. 5,861,199 could have been corrected prior to the expiration of the original patent is now moot.

**The case law and MPEP do not support the proposition that 35 U.S.C. § 251 permits reissue to disclaim continuity claims for the purpose of changing the term of a patent**

Brenner v. State of Israel, Sampson v. Commissioner of Patents and Trademarks, and MPEP 1402 do not support the proposition that 35 U.S.C. § 251 permits reissue to disclaim continuity claims for the purpose of attempting to change the term of a patent. Brenner v. State of Israel and Sampson v. Commissioner of Patents and Trademarks involve situations in which the applicant sought to add or correct a priority or benefit claim because the priority or benefit claim either might be or actually was necessary to protect the validity of the patent against intervening prior art. See Brenner v. State of Israel, 400 F.2d at 791, 158 USPQ at 585 (priority claim may be necessary to the validity of the patent being reissued), Sampson v. Commissioner of Patents and Trademarks, 195 USPQ at 136 (benefit claim was actually necessary to avoid a prior patent being a statutory bar under 35 U.S.C. § 102(b)). Likewise, the “correction” of priority or benefit claims discussed in MPEP 1402(d) pertains to the perfection of a priority or benefit claim (Brenner v. State of Israel) or the correction of the failure to make a priority or benefit claim

(Sampson v. Commissioner of Patents and Trademarks). MPEP 1402(d) does not address the situation in which the “correction” of a priority or benefit claim sought by the patentee via reissue amounts to a disclaimer of the priority or benefit claim, and does not suggest that 35 U.S.C. § 251 permits reissue to disclaim priority or benefit claims for the purpose of attempting to change the patent’s term.

While the addition or correction of a priority or benefit claim may be necessary to the validity of a patent, the disclaimer of a priority or benefit claim can only jeopardize the validity of a patent. Therefore, these decisions and MPEP 1402 do not stand for the proposition that 35 U.S.C. § 251 permits reissue to disclaim priority or benefit claims for the purposes of attempting to change the patent’s term. To the contrary, since 35 U.S.C. § 251, ¶ 1, expressly provides that a reissue patent is “for the unexpired term of the original patent,” it would be inconsistent with the plain language of the reissue statute for a patentee to attempt to employ its provisions for the purpose of reissuing a patent for a term that would extend beyond “the unexpired term of the original patent.” See MPEP 1405.

**The Director no longer has authority under 35 U.S.C. § 251 to reissue  
U.S. Patent No. 5,861,199**

As indicated by the U.S. Court of Appeals for the Federal Circuit (Federal Circuit): “[t]he language of [35 U.S.C. §] 251 is unambiguous: the [Director] has authority to reissue a patent only ‘for the unexpired term of the original patent.’” See In re Morgan, 990 F.2d at 1231, 26 USPQ2d at 1393 (quoting 35 U.S.C. § 251, ¶ 1). Thus, assuming (*arguendo*) that the conditions of 35 U.S.C. § 251 were otherwise satisfied, the Director had the authority to reissue U.S. Patent No. 5,861,199 only for a term that expired on May 23, 2004. See 35 U.S.C. § 251, ¶ 1 (“the Director shall . . . reissue the patent . . . for the unexpired part of the term of the original patent”). Since U.S. Patent No. 5,861,199 is now an expired patent, the decision of June 2, 2004 correctly indicated that the Director no longer has authority under 35 U.S.C. § 251 to reissue U.S. Patent No. 5,861,199. See Morgan, 990 F.2d at 1231, 26 USPQ2d at 1393.

While Morgan did not involve a situation in which the erroneous inclusion of continuing data in the patent was at issue, the salient points remain that: (1) the Federal Circuit held in Morgan that the language of the reissue statute (35 U.S.C. § 251) is unambiguous, in that the Director has authority to reissue a patent only for the unexpired term of the original patent; (2) the original patent at issue (U.S. Patent No. 5,861,199) expired on May 23, 2004; (3) the elimination of continuing data from U.S. Patent No. 5,861,199 via reissue will not change the May 23, 2004 expiration date of U.S. Patent No. 5,861,199; and (4) the USPTO cannot now reissue U.S. Patent No. 5,861,199 under 35 U.S.C. § 251 consistent with the holding of the Federal Circuit in Morgan.

### Conclusion

For the above-stated reasons, proceedings were properly terminated in the above-identified application because U.S. Patent No. 5,861,199 is an expired patent and 35 U.S.C. § 251 does not authorize reissue of an expired patent. See Morgan at 1232, 26 USPQ2d at 1394. Therefore, there is no basis for holding the termination of proceedings in the above-identified reissue application in abeyance pending review by the Board of Patent Appeals and Interferences as any appeal in the above-identified application is moot. See Morgan at 1231, 26 USPQ2d at 1393; see also Ex parte Kumagai, 9 USPQ2d 1642, 1646 (BPAI 1988) (the BPAI's jurisdiction under 35 U.S.C. § 134 ends once the term of the patent for which reissue is sought expires).

Petitioner's request to be permitted to have his day before the BPAI to have a full substantive resolution of the issues (petition of August 2, 2004 at 8) is misplaced. Even if the BPAI were to determine that the elimination of continuity claims under 35 U.S.C. § 120 in this situation is an error correctable via reissue under 35 U.S.C. § 251, such a reissue would not operate to extend the term of U.S. Patent No. 5,861,199. See MPEP 1405; see also BPAI remand of February 11, 2004 in application No. 09/678,217 at 5 (instructing examiner to also explain how the deletion of the continuity data would extend the term of the original patent since 35 U.S.C. § 251 provides that the Director "shall reissue the patent 'for the unexpired part of the term of the original patent'"). Petitioner, however, has sought and been given administrative review of the decision of June 2, 2004 terminating proceedings in the above-identified application. This decision is the substantive resolution of the issues presented by petitioner insofar as the USPTO is concerned.

The petition under 37 CFR 1.181(a)(3) filed on August 2, 2004, requesting supervisory review of the decision of June 2, 2004 terminating proceedings in the above-identified reissue application is granted to the extent that the decision of June 2, 2004 has been given supervisory review; however, the petition is **DENIED** with respect to holding the termination of proceedings in the above-identified reissue application in abeyance pending review by the BPAI, or otherwise disturbing the decision terminating proceedings in the above-identified reissue application.

The \$130.00 petition fee (37 CFR 1.17(h)) is **not** required for a petition under 37 CFR 1.181. Therefore, the \$130.00 petition fee charged to Deposit Account No. 04-1700 will be credited to Deposit Account No. 04-1700 in accordance with petitioner's instructions.

This decision may be viewed as a final agency action within the meaning of 5 U.S.C. § 704 and for purposes of seeking judicial review. See MPEP 1002.02.

Telephone inquiries concerning this decision may be directed to Robert W. Bahr at (703) 305-8850.

A handwritten signature in black ink, appearing to read "Stephen G. Kunin". The signature is fluid and cursive, with the first name "Stephen" and last name "Kunin" clearly distinguishable.

Stephen G. Kunin  
Deputy Commissioner  
for Patent Examination Policy